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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,565	06/05/2000	Yoshinori Miyazawa	1046.1214/JDH	7602

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EXAMINER

NGUYEN, DUSTIN

ART UNIT PAPER NUMBER

2154

DATE MAILED: 08/12/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/587,565

Applicant(s)

MIYAZAWA, YOSHINORI

Examiner

Dustin Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10-14 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-14 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 2, 4-8, 10-14, 16-18 are presented for examination.

Response to Remarks

2. Applicants request acknowledgement of priority for Japanese Patent Application No. 11-302548 filed October 25, 1999.
3. The acknowledgement had made by examiner in Office Action sent out on 06/05/2003.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 4-6, 10-12, 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- A. The following terms lack antecedent basis:
- | | | | |
|------|------------|---|-----------------------|
| I. | An E-mail | - | line 1, claims 4-6 |
| II. | A method | - | line 1, claims 10-12 |
| III. | A computer | - | line 1, claims 16-18. |

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 4 – 8, 10 – 14, 16 – 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara [US Patent No 5,938,725], in view of Spencer et al. [US Patent No 6,349,299].

8. As per claim 1, Hara discloses the invention substantially as claimed including an E-mail terminal device comprising:

a judging unit which judges whether or not a reply destination mail address extracted from an E-mail received is an address of a mailing list capable of broadcasting the same E-mail to a plurality of destinations at one time [col 2, lines 64-67; col 3, lines 51-60; and col 4, lines 48-56];

the reply destination mail address is the address of the mailing list [col 3, lines 61-col 4, lines 11],

a selecting unit which displays the at least one extracted mail address as a candidate for a reply destination from which a specified reply destination can be selected [col 3, lines 14-28; and col 4, lines 2-11].

Hara does not specifically disclose

an extracting unit which automatically extracts at least one mail address contained in a text of the E-mail received.

Spencer discloses

an extracting unit which automatically extracts at least one mail address contained in a text of the E-mail received [Figure 5D; col 7, lines 32-46; and col 9, lines 60-64].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hara and Spencer because Spencer's teaching would allow to determine all destination address of recipients in an efficient manner.

9. As per claim 2, Hara discloses the invention substantially as claimed including an E-mail terminal device comprising:

a first extracting unit which automatically extracts a reply destination mail address from a mail header of an E-mail received [Figure 4; col 2, lines 64-67; and col 6, lines 18-26];

a selecting unit which displays all the extracted mail addresses as candidates for reply destinations from which a specified reply destination can be selected [col 3, lines 1-3; and col 6, lines 29-40];

a judging unit which judges whether or not a reply destination mail address extracted from an E-mail received is an address of a mailing list capable of broadcasting the same E-mail to a plurality of destinations at one time [col 2, lines 64-67; col 3, lines 51-60; and col 4, lines 48-56];

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the second extracting unit, when the reply destination mail address is judged to be the address of the mailing list, automatically extracts the at least one mail address [col 3, lines 61-col 4, lines 11; and col 4, lines 48-56].

Hara does not specifically disclose

a second extracting unit which automatically extracts at least one mail address contained in a text of the E-mail received.

Spencer discloses

a second extracting unit which extracts at least one mail address contained in a text of the E-mail received [Figure 5D; col 7, lines 32-46; and col 9, lines 60-64];

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Hara and Spencer because Spencer's teaching would allow to determine all destination address of recipients in an efficient manner.

10. As per claim 4, Hara discloses a storage unit including a mail address book by which whether or not the reply destination mail address extracted from the mail header of the E-mail received is the address of the mailing list, can be judged [col 1, lines 10-20 and lines 29-37].

11. As per claim 5, Hara discloses a processing unit which stores [claim 1, lines 3-4; and col 2, lines 58-59], if the mail address extracted from the text of the E-mail received is not registered in the mail address book, a name of this unregistered mail address as a name unknown in the mail address book in a format of corresponding to the mail address [col 1, lines 35-37; and col 3, lines 56-59].

12. As per claim 6, Hara discloses a display unit which displays, when visibly displaying all the extracted mail addresses as the reply destination candidates, the name of the mail address extracted from the text of the received E-mail and unregistered in the mail address book as the name unknown in the format of corresponding to the mail address [Figure 4].

13. As per claims 7, 8, 10-12, they are method claimed of claims 1, 2, 4-6, they are rejected for similar reasons as stated above in claims 1, 2, 4-6.

14. As per claims 13, 14, 16-18, they are program product claimed of claims 1, 2, 4-6, they are rejected for similar reasons as stated above in claims 1, 2, 4-6.

15. Applicant's arguments with respect to claims 1, 2, 4-8, 10-14, 16-18 have been considered but are moot in view of the new ground(s) of rejection.

16. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (703) 305-5321. The examiner can normally be reached on Monday – Friday (8:00 – 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directly to the receptionist whose telephone number is (703) 305-3900.

Dustin Nguyen

 JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100